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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,450	05/09/2001	Martin F. Yanofsky	19452A002400	6298

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EXAMINER

BAUM, STUART F

ART UNIT PAPER NUMBER

1638

DATE MAILED: 09/27/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/853,450

Applicant(s)

YANOFSKY ET AL.

Examiner

Stuart Baum

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-65 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, 12, 14-35, 37, and 39-65 are drawn to a transgenic plant comprising two nucleic acid coding sequences operably linked to a modified gene regulatory element wherein the first and second nucleic acid coding sequences are both in sense orientation, and a method of modulating the timing of reproductive development, classified in class 800, subclass 290 for example.
- II. Claims 1-10, 13-35, 38-65 are drawn to a transgenic plant comprising two nucleic acid coding sequences operably linked to a modified gene regulatory element wherein the first sequence is in sense orientation and the second nucleic acid coding sequence is in antisense orientation, and a method of modulating the timing of reproductive development, classified in class 800, subclass 290 for example.
- III. Claims 1-9, 11, 13, 14-34, 36, 38-65 are drawn to a transgenic plant comprising two nucleic acid coding sequences operably linked to a modified gene regulatory element wherein the first and second nucleic acid coding sequences are both in antisense orientation, and a method of modulating the timing of reproductive development, classified in class 800, subclass 290 for example.
- IV. Claims 1-9, 11-12, 14-34, 36-37, 39-65 are drawn to a transgenic plant comprising two nucleic acid coding sequences operably linked to a modified gene

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regulatory element wherein the first sequence is in antisense orientation and the second nucleic acid coding sequence is in sense orientation, and a method of modulating the timing of reproductive development, classified in class 800, subclass 290 for example.

Claims 1-9, 14-15, 32-34, and 39-47 are generic to Groups I-IV and will be examined to the extent that they read on the elected invention.

When electing one of Groups I-IV, Applicant is also to select two sequences; one from **GROUP "A"** and one from the **GROUP "B"**.

**GROUP "A":**

SEQ ID NO:2	SEQ ID NO:4	SEQ ID NO:6	SEQ ID NO:8
SEQ ID NO:10	SEQ ID NO:12		

**GROUP "B":**

SEQ ID NO:28	SEQ ID NO:30	SEQ ID NO:32	SEQ ID NO:38
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The inventions are distinct, each from the other because of the following reasons:

Inventions I to IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions use a combination of nucleic acids oriented in either sense or antisense orientation. Ones skilled in the art recognizes that nucleic acids in sense orientation act to increase the

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expression of a designated gene thereby increasing the activity of the corresponding gene product (protein) within the plant tissue whereas expressing a gene in antisense orientation has the effect of decreasing the activity of the corresponding gene product within said plant tissue.

Applicant is reminded that nucleotide sequences either encoding different proteins or specifying specific expression patterns are structurally distinct chemical compounds and are unrelated to one another, as are different proteins structurally distinct chemical compounds and unrelated to one another. These sequences are thus deemed to normally constitute **independent and distinct** inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq (see MPEP 803.04 and 2434). This requirement is not to be construed as a requirement for an election of species, since each nucleotide and amino acid sequence is not a member of a single genus of invention, but constitutes an independent and patentably distinct invention.

Each of Inventions I-IV are capable of being separately made, independently used, and the patentability of one does not render the others obvious or unpatentable.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, fields of search, and classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

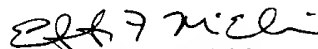
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stuart Baum whose telephone number is (703) 305-6997. The examiner can normally be reached on Monday-Friday 8:30AM – 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 or (703) 305-3014 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the legal analyst, Sonya Williams, whose telephone number is (703) 305-2272.

Stuart Baum Ph.D.

September 11, 2002

  
ELIZABETH F. McELWAIN  
PRIMARY EXAMINER  
GROUP 1800